

**REMARKS**

**INTRODUCTION:**

In accordance with the foregoing, claims 2-3, 6-7 and 10-11 have been canceled without prejudice or disclaimer, and claims 1, 4, 5, 8, 9, 12, 13 and 16 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1, 4, 5, 8, 9, and 12-16 are pending and under consideration. Claims 14-15 have been allowed. Reconsideration is respectfully requested.

**REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION:**

It has been noted that the present action has been marked final despite the fact that the Examiner had issued a new prior art rejection. In view of the fact that a number of the claims had only minor claim amendments which would not have necessitated a new rejection, it appears that the finality of the Office Action was improper. Accordingly, it is respectfully requested that the finality of this Office Action be withdrawn.

**ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116:**

Applicants request entry of this Rule 116 Response and Request for Reconsideration because:

- (a) at least certain of the rejected claims have been canceled thereby at least reducing the issues for appeal;
- (b) it is believed that the amendments of claims 1, 4, 5, 8, 9, 12, 13 and 16 put this application into condition for allowance;
- (c) the amendments were not earlier presented because the Applicants believed in good faith that the cited prior art did not disclose the present invention as previously claimed; and/or
- (d) the amendments of claims 1, 4, 5, 8, 9, 12, 13 and 16 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." ( Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry

should be explained expressly in the Advisory Action.

**REJECTION UNDER 35 U.S.C. §103:**

In the Office Action, at pages 2-6, numbered paragraph 1, claims 1-10, 13 and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Moringa (JP-203259A; hereafter, Morinaga) in view of Park et al. (USPN 6,859,933; hereafter, Park) and Hirasaka (USPN 6,690,540; hereafter, Hirasaka). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Independent claim 1 has been amended to include the features of claims 2 and 3. Claims 2 and 3 have been cancelled without prejudice or disclaimer. Claim 4 has been amended to depend from amended claim 1.

The Examiner admits that Morinaga does not show that the dampers selectively reduce noise of at least two predetermined frequency bands. Although the Examiner suggests that a resonator may be modified to fit the present claimed invention starting with Park and combining Morinaga and Hirasaka, it is respectfully submitted that Park teaches away from utilizing the Park invention to cancel frequencies above about 80 Hz. FIG. 7 of Park shows that only frequencies below about 80 Hz are cancelled, and that frequencies above about 80 Hz are not cancelled by the Park invention. Further, Park teaches that the "natural frequencies" of disk players for which the Park invention is suited are about 60 Hz (see Park, col. 6, lines 1-33). Thus, it is respectfully submitted that Park teaches away from canceling frequencies above 200 Hz, as is recited in amended claim 1 of the present invention. The specification of the present invention points out that it is necessary to utilize the present invention to selectively reduce noise of a high noise frequency band, for example, a noise frequency band that is greater than 200 HZ (see specification, paragraphs [0038] through [0041]. Hirasaka teaches using a damper attached to a disk drive apparatus and enabled to repress vibration, comprising: a flat portion having a jointing surface adapted to engage the disk drive apparatus; a mass-increased portion disposed in an outer periphery area of the flat portion that is greater than the flat portion in mass per unit area; and wherein the mass-increased portion is formed from a material having a specific gravity that is greater than that of any other portions of the damper (see claim 1 of Hirasaka). The flat damper of Hirasaka is a different device, and functions differently than the resonator of the present claimed invention.

Applicants submit that an argument can always be made that combining references would enhance or improve a certain feature because the claimed invention typically produces a benefit or improvement. Generally, the purpose in combining references is not to show that the combination will worsen or degrade a feature. However, the Examiner "can satisfy the burden of

obviousness in light of combination 'only by showing some objective teaching [leading to the combination].'" In re Dembiczak, 50 USPQ2d 1614, 1617 (CAFC 1999), *quoting In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Further, "evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved ... The range of sources available, however, does not diminish the requirement for actual evidence." Dembiczak, 50 USPQ2d 1617. The Examiner has not provided evidence that the teaching he proposes actually exists in the prior art. In fact, his reasoning appears to have merely come from Applicants' specification.

Hence, even if combined, Morinaga, Park and Hirasaka do not teach or suggest amended claim 1 of the present invention. Thus, amended claim 1 of the present invention is submitted to be patentable under 35 U.S.C. §103(a) over Moringa (JP-203259A) in view of Park et al. (USPN 6,859,933) and Hirasaka (USPN 6,690,540).

Independent claim 5 has been amended to include the features of claims 6 and 7. Claims 6 and 7 have been cancelled without prejudice or disclaimer. Claim 8 has been amended to depend from amended claim 5. As recited above, Morinaga does not teach or suggest that the dampers selectively reduce noise of at least two predetermined frequency bands. Park teaches away from the present claimed invention by teaching only causing interference with frequencies less than 200 Hz. The role of the specification is neither to limit nor to broaden the claims, but to define, as a matter of law, the invention that has been patented. The claims are always construed in light of the specification, of which they are a part. See *Slimfold Mfg. Co. v Kinkead Indus., Inc.* 810 F.2d 1113, 1118 1 USPQ2d 1563, 1566 (Fed. Cir. 1987). Further, as noted above, there is no teaching or suggestion by the combination of Morinaga, Park and Hirasaks of the disk drive recited in amended claim 5 of the present invention. Hirasaka teaches using a damper attached to a disk drive apparatus and enabled to repress vibration, comprising: a flat portion having a jointing surface adapted to engage the disk drive apparatus; a mass-increased portion disposed in an outer periphery area of the flat portion that is greater than the flat portion in mass per unit area; and wherein the mass-increased portion is formed from a material having a specific gravity that is greater than that of any other portions of the damper (see claim 1 of Hirasaka). The flat damper of Hirasaka is a different device, and function differently than the resonator of the present claimed invention.

Hence, even if combined, , Morinaga, Park and Hirasaka do not teach or suggest amended claim 5 of the present invention. Thus, amended claim 5 of the present invention is submitted to be patentable under 35 U.S.C. §103(a) over Moringa (JP-203259A) in view of Park et al. (USPN 6,859,933) and Hirasaka (USPN 6,690,540).

Independent claim 9 has been amended to include the features of claims 10 and 11. Claims 10 and 11 have been cancelled without prejudice or disclaimer. Claim 12 has been amended to depend from amended claim 9. Thus, as set forth by the Examiner on page 6 of the Office Action, amended claims 9 and 12 are submitted to be in allowable form.

Independent claim 13 has been amended to recite, in part: "wherein the resonator further comprises an absorbing member ~~filling that is porous and fills~~ the resonance container to selectively reduce noise of a frequency band larger than the predetermined frequency band." Hence, amended claim 13 is in allowable form because amended claim 13 recites claim 14, which has been allowed, with a further limitation that the predetermined frequency band corresponds to a dominant noise frequency band above 200 Hz.

Independent claim 16 has been amended to add the terminology "wherein at least one resonator is a Helmholtz resonator comprising an absorbing member filling a resonance container surrounding the through hole and having a predetermined volume, the resonator being mounted on the disk tray to selectively reduce noise of a predetermined frequency band, the predetermined frequency band being determined according to an area of a profile of the through hole, a length of the bottle neck of the through hole, and the volume of the resonance container, and wherein air in the bottle neck begins to resonate to cause interference that causes frequency cancellation for a frequency larger than the predetermined frequency band," which is supported by paragraphs [0033] through [0034] of the specification.

It is respectfully submitted that, for the reasons recited above, and for the reason that none of Morinaga, Park or Hirasaka teach or suggest using a Helmholtz resonator, as is recited in amended independent claim 16 of the present invention, amended claim 16 of the present invention is patentable under 35 U.S.C. §103(a) over Moringa (JP-203259A) in view of Park et al. (USPN 6,859,933) and Hirasaka (USPN 6,690,540).

#### **ALLOWABLE SUBJECT MATTER:**

In the Office Action, at page 6, numbered paragraph 2, claims 14 and 15 were allowed.

Applicants thank the Examiner for his careful consideration and allowance of claims 14 and 15.

In the Office Action, at page 6, numbered paragraph 2, claims 11 and 12 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 9 has been amended to include the features of claims 10 and 11, as suggested by the Examiner. Claims 10 and 11 have been cancelled without prejudice or disclaimer. Claim 12 has been updated to depend from amended claim 9. Thus, it is respectfully submitted that

amended claims 9 and 12 are in form for allowance.

**CONCLUSION:**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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